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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/597,741 | 09/26/2006 | Daniel Deriaz | P30124 | 5632 |
| 7055 | 7590 | 10/22/2007 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | WOLFE, DEBRA M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3725 | | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 10/22/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gpatent@gpatent.com
pto@gpatent.com

Office Action Summary

| | | | |
|-----------------|----------------|--------------|---------------|
| Application No. | 10/597,741 | Applicant(s) | DERIAZ ET AL. |
| Examiner | Debra M. Wolfe | Art Unit | 3725 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on August 4, 2006 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
6) Other: _____



DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: numerals 20, 21 and 22. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the longitudinally profiled cylindrical mandrel must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.



Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter of claim 3, specifically the first and secondary headstock and the coupling are not described in the specification for one of ordinary skill in the art would know how it interacts with the rest of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the drive" in line 5. Claim 9 recites the limitation "the drive" and "the advancement movement" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –



(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 4, 5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cretin et al (US Patent # 5,339,669). Cretin et al discloses a device for the manufacture of cylindrical work pieces (7) which have a defined profiling, with an axially movable work piece holder (5) intermittently rotatable about the longitudinal axis and forming tools (9A, 9B) periodically acting on the work piece (7) wherein at least one separate drive (71) mechanically separate from the drive (11) of the forming tools (9A, 9B) is provided, which is connected with an electronic control which controls the intermittent rotational movement of the work piece holder (5) in dependence of the drive of the forming tools (9A, 9B) [See col. 5 line 64- col. 6 line 14].

In reference to claim 2, the forming tools (9A, 9B) are profiled wheels, which are driven to continually rotate along a circular orbit whereby the circular orbit is preferably oriented parallel or obliquely to the longitudinal axis of the work piece (7).

In reference to claim 4, the periodic movement of the forming tools (9A, 9B), the intermittent rotational movement of the work piece holder (5), as well as the axial advancement of the work piece holder (5) have separate drive units (11, 71, 73) which are electronically couples with one another and preferably connected with the electronic control.

In reference to claim 5, the work piece (7) are cylindrical solid or hollow bodies.

In reference to claim 7, Cretin et al discloses a method of producing cylindrical work pieces (7) having a defined profiling with an axially movable work piece holder (5) for the work pieces (7), which is intermittently rotatable about the longitudinal axis, as well as forming tools (9A, 9B) periodically acting on the work piece (7) wherein the work piece (7) is rotated about its



longitudinal axis by way of an electronic control and a drive (71) separate from the forming tools (9A, 9B) in dependence of the movement of the forming tools (9A, 9B) for the generation of a predetermined defined profiling geometry on the work piece (7) [See col. 5 line 64 – col. 6 line 14].

In reference to claim 8, the control imposes on the work piece (7) left and right hand rotation as well as a standsill.

In reference to claim 9, the control also controls the drive (11) and the advancement movement of the forming tools (9A, 9B) according to preselected settings, as well as the axial advancement movement of the work piece (7).

In reference to claim 10, the device of Cretin et al is capable of manufacturing a cylindrical work piece with helical toothings.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cretin et al in view of Schuler et al (US Patent # 5,001,916). Cretin et al discloses the invention substantially as claimed except for wherein the work piece is mounted on a longitudinally profiled cylindrical mandrel. However, Schuler et al teaches that it is known in the art to mount a hollow cylindrical work piece on a profiled mandrel in order to form internal toothings [See col. 7 line 22-44].



Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the work piece holder of Cretin et al with the profiled cylindrical mandrel of Schuler et al in order to produce a cylindrical work piece with internal toothings.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra Wolfe whose telephone number is (571) 272-1904. The examiner can normally be reached Monday - Thursday 7am - 4:30pm with alternating Friday 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra M Wolfe
Examiner
Art Unit 3725

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700